REMARKS

Claims 1-22 and 28-30 are pending in this application. By this Amendment, Applicant amends claims 1-6, 12-16, 28, and 30. Applicant amends independent claim 1 to incorporate the limitations of its dependent claim 5, and similarly amend independent claims 2 and 3. Applicant amends independent claim 12 to incorporate the limitations of dependent claim 15, and similarly amend independent claims 13, 28, and 30. Support for the amendment may be found at, for example, Figures 14-20 and corresponding disclosures (e.g., Specification, pg. 15, line 10 to pg. 16, line 12; pg. 16, line 39 to pg. 20, line 1; and pg. 20, line 36 to pg. 21, line 27). No new matter is added. Reconsideration of the application is respectfully requested.

I. Claims Define Patentable Subject Matter

A. Claims 1-3 recite Patent Eligible Subject Matter

The Office Action rejects claims 1-3 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action states that the claim limitation of claims 1-3 raises a question as to whether the claimed invention is directed merely to an abstract idea that is not tied to producing a concrete, useful, and tangible result (Office Action, pg. 3, line 25-pg. 4, line 8). Moreover, the Office Action alleges that claims 1-3 "are not a statutory system and should be rejected under 35 U.S.C. § 101 as not being tangible" because every "means for" limitation recites to a computer program software system that is not embedded in any computer-readable medium and run by a computer or machine (Office Action, pg. 4, ll. 5-8). Applicant respectfully traverses this rejection.

In the precedential opinion *Ex parte Lundgren*, the Board of Patent Appeals and Interferences held that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." *Ex parte Lundgren*, Appeal No.

2003-2088 (B.P.A.I. 2005). Moreover, the Interim Guidelines for Examination of Patent Applications clearly states that "the following tests are not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter: (A) 'not in the technological arts' test; (B) Freeman-Walter-Abele test; (C) mental step or human step tests; (D) the machine-implemented test; and (E) the per se data transformation test," and that "[t]here is no other recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas." Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Annex III (October 26, 2005). Applicant contends that the claims clearly recite statutory subject matter under the judicially recognized test set forth by the Federal Circuit and followed by the M.P.E.P.: that the claimed invention as a whole produces a "useful, concrete and tangible result...." *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1369, 1373 (Fed. Cir. 1998); see M.P.E.P. § 2106.

Even if claims 1-3 "include no physical structure of the machine in terms of its hardware or hardware and software combination" as alleged on page 4, lines 3 and 4 of the Office Action, an allegation to which Applicant contends, claims 1-3 clearly recite statutory subject matter because the invention claimed as a whole produces a useful, concrete, and tangible result. Thus, in light of the Board's *Lundgren* opinion, Applicant requests the reconsideration and withdrawal of the § 101 rejection of claims 1-3.

B. Claims 1-22 and 28-30 are Patentable Over Cited Prior Art

The Office Action rejects claims 1-22 and 28-30 under 35 U.S.C. § 103(a) over Huston et al. (U.S. Patent Application Publication No. 2002/0007402; hereinafter *Huston*) in view of *David* (U.S. Patent No. 6,801,902), and further in view of *Hiraizumi* (U.S. Patent No. 5,550,977). The rejection is respectfully traversed.

With respect to independent claims 1-3, Applicant asserts that *Huston, David,* and *Hiraizumi,* individually or in combination, fail to disclose or suggest an electronic information management system for classification and retrieval of documents including at least image feature extracting means for <u>extracting a feature of an image based on an instruction from a client</u>, the feature associated with electronic information stored in storing means connected to a network, and deleting means for deleting from the storing means via the network and via a deletion method specified by the client unnecessary electronic information, <u>the deleting means includes at least one of means for deleting information that matches a predetermined condition and means for deleting the information after having checked the condition specified by the client</u>, as recited in amended independent claims 1-3 and similarly recited in independent claims 12, 13, 28, and 30.

First, *Huston* discloses a differencing engine that selectively causes content to be refreshed in a cache (*Huston,* abstract; pg. 3, ¶ [0024]) that detects whether a more recent version of a data item is available, and if so, deletes the data item from the cache and retrieve and store the more recent version of the data item in the cache (*Huston,* abstract; Fig. 2B). However, while the differencing engine in *Huston* may retrieve replacement content after receiving a user request for the deleted content (*Huston,* pg. 3, ¶ [0037]), the differencing engine refreshes content <u>independent of any request for the data by the user</u> (*Huston,* pg. 2, ¶¶ [0020] and [0021]; pg. 3, ¶ [0024]). Moreover, *Huston* makes no mention of image feature extraction. Therefore, *Huston* fails to disclose or suggest an electronic information management system including at least image feature extracting means and deleting means as recited in amended independent claims 1-3, and similarly recited in independent claims 12, 13, 28, and 30.

Because *David* also fails to disclose or suggest an electronic information management system as recited in the amended independent claims, *David* fails to cure the deficiencies of

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Huston. Moreover, as the Office Action <u>admits,</u> *Huston* in view of *David* <u>does not teach</u> that the detecting means includes at least one of deleting information that matches a predetermined condition and deleting the information after having checked the condition (Office Action, pg. 6, ll. 12-14). Accordingly, a combination of *Huston* and *David* would <u>not</u> arrive at the subject matter as recited in claim 1-3, and similarly recited in independent claims 12, 13, 28, and 30.

Next, the Office Action alleges that *Hiraizumi* cures the deficiencies of *Huston* and *David* (Office Action, pg. 6, ll. 12-14). Applicant respectfully disagrees. *Hiraizumi* discloses a multi-media mailing system having a plurality of mailing centers in a network (*Hiraizumi,* Fig. 1). In *Hiraizumi,* when a subscriber makes a request for deletion processing of particular information at a first one of the mailing centers, the mailing system inhibits processing by any other subscriber to a second one of the mailing centers other than the first mailing center (*Hiraizumi,* col. 5, ll. 39-53). However, *Hiraizumi's* disclosure of inhibiting processing of particular information on other mailing centers by <u>other subscribers</u> does not constitute a teaching of an electronic information management system for classification and retrieval of documents including at least image feature extracting means for <u>extracting a feature of an image based on an instruction from a client</u>, the feature associated with electronic information stored in storing means connected to a network, and deleting means for deleting from the storing means via the network and via a deletion method specified by the client unnecessary electronic information, <u>the deleting means includes at least one of means for deleting information that matches a predetermined condition and means for deleting the information after having checked the condition specified by the client</u>, as recited in amended independent claims 1-3. Accordingly, a combination of *Huston, David,* and *Hiraizumi* would <u>not</u> arrive at the subject matter as recited in claims 1-3 and similarly recited in independent claims 12, 13, 28, and 30.
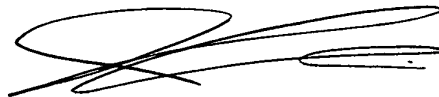
Thus, the above-mentioned independent claims, and their dependent claims, are patentable over a combination of the applied references. Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 and 28-30 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

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